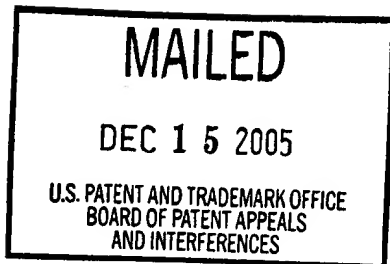


The opinion in support of the decision being entered today was not written
for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JAMES A. WESTHOFF
and
JAMES A. KELLY



Appeal No. 2005-2519
Application No. 09/395,106

HEARD: December 13, 2005

Before FRANKFORT, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 21 to 26, 41, 45 and 46. Claims 30 to 36, which are all of the other claims pending in this application, have been allowed.

We AFFIRM-IN-PART.

BACKGROUND

The appellants' invention relates to a method and apparatus for producing cast members in which members utilized to form step inserts and/or to support reinforcement members are provided with means to prevent undesirable seepage of the cast material and thereby retain the cast material into the mold assemblies within the mold assembly as the cast material sets (specification, p. 1).

The following two rejections are under appeal:

1. Claim 41 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 1,185,765 to Brooks.
2. Claims 21 to 26, 45 and 46 under 35 U.S.C. § 103 as being unpatentable over Brooks in view of the German publication number DT 26 06 498 A1 to Summerlin et al. (Summerlin).

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (mailed August 6, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed January 23, 2003) and reply brief (filed October 12, 2004) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The anticipation rejection

We sustain the rejection of claim 41 under 35 U.S.C. § 102(b).

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

Claim 41 reads as follows:

An insert which is embedded in a cast member for force-fittingly receiving a leg portion of a step, said insert being comprised of:

a hollow, substantially cylindrical-shaped, elongated housing having a generally smooth cylindrical outer surface and having an open end and a closed end;

one of said ends having a flange lying in a plane perpendicular to a longitudinal axis of said housing; and

an interior surface of said housing having a portion thereof provided with a plurality of annular inwardly projecting spaced apart projections; and

said closed end having an exterior surface with at least a portion of the exterior surface lying in a plane being inclined relative to said longitudinal axis.

Brooks' invention is related to a screw or attaching socket used in concrete construction. Figures 1-2 illustrate one form of a socket embodying Brooks' invention. Figure 3 illustrates a modified form of the socket intended for use where the concrete body is comparatively thin.

The socket shown in Figures 1-2 of Brooks comprises a hollow shank portion 1 having an open inner end adapted to provide a flanged top 2 and an interiorly threaded outer end 3. Extending across the interior of the shank portion is a partition 4 to prevent concrete which enters the open inner end from clogging the threaded outer end. The socket is provided with laterally extending projections 5 having notches 6 adapted to receive nails for securing the socket to concrete forms as indicated in dotted lines in Figure 1. The socket is further provided both exteriorly and interiorly with locking projections 8 and 9. The flanged inner end of the socket is frusto-conical of considerable diameter to afford amply anchorage of the socket in the concrete mass.

The inner face of the frustro-conical flange is provided with annular locking ribs 10 to increase the hold of the concrete on the socket.

Figure 3 of Brooks shows a shorter socket adapted for use in thinner masses of concrete. As shown, this shorter socket has the frustro-conical flange top 2 projecting from the shank portion 1 at the location of the partition 4. This socket may be used vertically, horizontally or otherwise. In addition, Brooks teaches (page 1, lines 75-80) that in lieu of the threaded outer end 3 there may be provided any other desired attaching means.

The appellants argue (brief, pp. 5-6; reply brief, p. 1) that Brooks does not disclose an insert comprising of a hollow, substantially cylindrical-shaped, elongated housing having a generally smooth cylindrical outer surface and having an open end and a closed end with the closed end having an exterior surface with at least a portion of the exterior surface lying in a plane being inclined relative to the longitudinal axis of the housing. The examiner's response to this argument (answer, p. 6) is that "Brooks figure 1 shows the frustro-conical flange being in a plane as cross section of the flange clearly shows the flange in a plane."

In our view, claim 41 is anticipated by the shorter socket depicted in Figure 3 of Brooks. Clearly, Brooks' shorter socket includes a hollow, substantially cylindrical-shaped, elongated housing having a generally smooth cylindrical outer surface (i.e., shank portion 1) and having an open end (at threaded outer end 3) and a closed end (at partition 4 and frustro-conical flange top 2). The closed end of Brooks' shorter socket has an exterior surface (the exterior surfaces of partition 4 and frustro-conical flange top 2) with at least a portion of the exterior surface lying in a plane being inclined relative to the longitudinal axis of the housing (i.e., the vertical section view of Brooks' shorter socket depicted in Figure 3 shows a portion of the exterior surface of the frustro-conical flange top 2 (i.e., the line of the exterior surface of the frustro-conical flange top 2 through which the vertical section has been taken) lying in a plane being inclined relative to the longitudinal axis of the shank portion 1). As such, the frustro-conical flange top 2 and partition 4 of Brooks' shorter socket together define a closed end with the closed end having an exterior surface with at least a portion of the exterior surface lying in a plane being inclined relative to the longitudinal axis of the housing.

For the reasons set forth above, claim 41 is anticipated by Brooks. Accordingly, the decision of the examiner to reject claim 41 under 35 U.S.C. § 102(b) is affirmed.

The obviousness rejection

We will not sustain the rejection of claims 21 to 26, 45 and 46 under 35 U.S.C. § 103.

Claim 21, the only independent claim subject to this ground of rejection, reads as follows:

An insert adapted to be embedded in a cast member for force-fittingly receiving a leg portion of a step, said insert being comprised of:
a hollow, substantially cylindrical-shaped elongated housing having an open end and a closed end;
one of the open end and the closed end having a flange lying in a plane diagonally aligned with a longitudinal axis of said housing;
another one of the open end and the closed end having a flange lying in a plane perpendicular to said longitudinal axis;
an interior surface of said housing having a portion thereof being provided with a plurality of projections arranged at spaced intervals and extending radially inward;
each of the plurality of projections having a tapering cross-section defined by a first surface diagonally aligned with the longitudinal axis and facing the open end and a second surface perpendicular to said longitudinal axis and facing the closed end.

In the rejection of claim 21, the examiner (answer, pp. 4-6) determined that Brooks taught all of the claimed subject matter except that Brooks does not show "the second surface of the projections being perpendicular to said longitudinal axis and facing the closed end." The examiner then concluded that such a modification of

Brooks would have been obvious at the time the invention was made to a person having ordinary skill in the art from the teachings of Summerlin.

The appellants argue (brief, pp. 7-8; reply brief, p. 2) that the examiner's determination that Brooks taught all of the claimed subject matter except that Brooks does not show "the second surface of the projections being perpendicular to said longitudinal axis and facing the closed end" is in error. Specifically, the appellants assert that Brooks does not disclose an insert comprised of a hollow, substantially cylindrical-shaped elongated housing having an open end and a closed end wherein one of the open end and the closed end has a flange lying in a plane diagonally aligned with a longitudinal axis of said housing while the other one of the open end or the closed end has a flange lying in a plane perpendicular to the longitudinal axis.

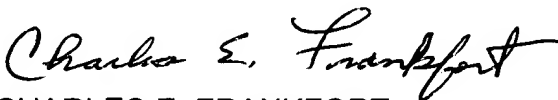
In contrast to our treatment of claim 41 as set forth above, it is our view that the end of Brooks' socket with the frusto-conical flange top 2 does not define, in any way, an end having "a flange lying in a plane diagonally aligned with a longitudinal axis of said housing." For that reason, the combined teachings of Brooks and Summerlin are not suggestive of the subject matter of claim 21. Accordingly, the decision of the examiner to reject claim 21, and claims 22 to 26, 45 and 46 dependent thereon, under 35 U.S.C. § 103 is reversed.

CONCLUSION

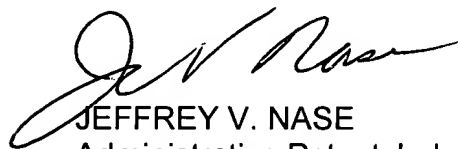
To summarize, the decision of the examiner to reject claim 41 under 35 U.S.C. § 102(b) is affirmed and the decision of the examiner to reject claims 21 to 26, 45 and 46 under 35 U.S.C. § 103 is reversed.

No period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART



CHARLES E. FRANKFORT
Administrative Patent Judge



JEFFREY V. NASE
Administrative Patent Judge



JENNIFER D. BAHR
Administrative Patent Judge

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